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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/299,068	04/23/1999	WILL F. WILLIAMSON	25932-5	2791

7590

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EXAMINER

MEDLEY, MARGARET B

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 06/30/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/299,068

Applicant(s)

WILLIAMSON ET AL.

Examiner

Margaret B. Medley

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 October 2002 and 10 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-12,14-21,23-29 and 31-36 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

- 6) ☒ Claim(s) 1,2,4-12,14-21,23-29 and 31-36 is/are rejected.

- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.

- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)

- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 33.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

- 5) ☐ Notice of Informal Patent Application (PTO-152)

- 6) ☐ Other:

### **DETAILED ACTION**

This office action is in response to the petition that was granted in Paper No. 32 dated June 27, 2003.

The improper CPA filed in Paper No. 23 dated October 15, 2002 has been converted to a RCE and an action on the merits appears below.

The amendment in Paper No. 26 dated December 10, 2002 has been entered of record. Claims 3, 13, 22 and 30 were cancelled. The amendments to claims 2, 4, 10, 12, 14, 21, 23, 29, 31 and 36 were entered of record. The pending claims are claims 1-2, 4-12, 14-21, 23-29 and 31-36.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 4, 10, 12, 14, 23 and 36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, 14 and 23 depends on cancelled claim 3, 13 and 22, respectively, and therefore are indefinite. In the interest of compact prosecution claims 3, 14 and 23 will be treated on the merits as depending from claim 1, 11, and 20, respectively.

Applicants are required to clarify the record as to the proper dependency of claims 4, 14 and 23.

The limitation in claims 12 and 14 that "The anti-wear compound of claim 11" is confusing in that claims depends from claim 11 directed to "A process for the synthesizing an anti-wear compound". The preamble of claims 12 and 14 should corrected to coincide with the preamble of claim 11.

Claim 36 appears to duplicate claim 10 and therefore is indefinite for not providing a further limitation of the claimed invention. It is suggested that applicants should cancel one of the claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-2, 4-9, 11-12, 14-19 and 36 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kaza et al (Kaza) 4,574,057 in view of Urushibata et al

(Urushibata) 5,304,316 and Lindemann 3,322,703 for reasons made of record in Paper No. 21 dated April 25,2002.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 4-12, 14-21, 23-29 and 31-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 8-19 and 21-31 of U.S. Patent No. 6,239,298 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same components are reacted by the same process to produce the same additives, the additives are used in the same composition and lubrication composition as that of patentee to render the Patent '298 obvious.

Claim 10 is objected to for depending on a rejected claim.

Claims 20-21, 23-29 and 31-35 appear to contain allowable subject matter and would be allowed upon applicants submission of a proper terminal disclaimer with the proper fee to over come the double patent issue and to over the 112 issues.

Applicant's arguments filed December 10, 2002 have been fully considered but they are not persuasive.

Applicants present arguments at page 8-11 of Paper No 26 that the 103 rejection is improper because of the inapplicability of non-analogous art. The examiner agrees with applicants' arguments with respect to claims 20-21, 23-29 and 31-35. Therefore the 103 rejection over claims 20-21, 23-29 and 31-35 are withdrawn. However, the arguments do not apply to the additive reaction products and the process for producing the said reaction products. A review and study of the examples of the primary reference clearly teaches the artisan in the art to produce an intermediate and then follow with the alcohol reactant. Applicants attention is referred to the first full paragraph on page 5 of Paper No.21 dated April 25, 2002. The burden is shifted to applicants to show that product differences in product by process claims. One cannot shift the burden by arguing non-analogous art.

The previous 112 issues are withdrawn in view of applicants' amendments to the claims and the cancellation of others.

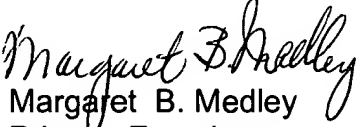
The prior art made of record and not relied upon further teaches additives, reaction and compositions of the same nature as claimed by applicants.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret B. Medley whose telephone number is 703-308-2518. The examiner can normally be reached on Monday-Friday from 7;30 AM to 6;00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
Margaret B. Medley  
Primary Examiner  
Art Unit 1714

MMedley

June 28, 2003